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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/719,559      | 03/02/2001  | Reinhard Plaschka    | JEK/PILASCHKA       | 3460             |

7590 01/23/2004  
Bacon & Thomas  
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Alexandria, VA 23124-1176

EXAMINER

FERGUSON, LAWRENCE D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1774

DATE MAILED: 01/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/719,559

Applicant(s)

PLASCHKA ET AL.

Examiner

Lawrence D Ferguson

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18, 19 and 21-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18, 19 and 21-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. This action is in response to the amendment mailed December 10, 2003.  
Claim 18 was amended and claim 20 was cancelled rendering claims 18-19 and 21-37 pending. Examiner regrets the withdrawal of the previous indication of claim 20 being allowable subject matter and further prosecutes the case based on newly acquired prior art.

### *Claim Rejections – 35 USC § 103(a)*

2. The following is a quotation of 35 U.S.C. 103:

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 18-19, 21, 23, 26-28 and 35 rejected under 35 U.S.C. 103(a) as being unpatentable over Henbo et al. (U.S. 5,871,833).

Henbo discloses a security paper comprising a support layer and coating layer (column 2, lines 26-28) where the coating layer includes acrylates and a mixture of acrylate and non-acrylate copolymers (column 5, lines 4-24). The coating layer lacks polyurethane and a filler substance. Henbo discloses forgery preventive (security paper) is clearly recognized when held up to a light (visually detectable) (column 13 lines 8-15).

Art Unit: 1774

The reference discloses the use of pigments (column 5, lines 25-40) and Figure 2 shows the coating provided on the paper only in predetermined areas. In instant claim 18, the phrase, "a paper layer useful for producing documents of value" is directed to intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Although Henbo does not explicitly disclose a dirt repellent surface, because the coating is positioned over a layer of the security paper, the coating keeps dirt from forming on paper. Henbo does not show that the security paper has a coating weight as in instant claim 19. However, such coating weight is a property which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the coating weight, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. coating weight) fails to render claims patentable in the absence of unexpected results. The coating weight is optimizable as it directly affects the durability and mechanical strength of the security paper. As such, it is optimizable. It would have been obvious to one of ordinary skill in the art to make the security paper with the limitations of the coating weight since it has been held that discovering an

optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980).

***Claim Rejections – 35 USC § 103(a)***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 22, 24-25 and 38-40 rejected under 35 U.S.C. 103(a) as being unpatentable over Henbo et al. (U.S. 5,871,833) in view of Melling et al. (U.S. 5,943,093).

Henbo is relied on for claims 18-19, 21, 23, 26-28 and 35 as indicated above. Henbo discloses a print pattern is formed between the support layer and coating layer for forgery prevention (column 5, lines 47-59) However, Henbo does not disclose luminescent properties, the paper comprising cotton or plastic fibers. Melling teaches a security paper having a coating (column 1, line 61 through column 2, line 60) having fluorescent material (luminescent) having pigmented coloring materials which can transmit or reflect light (column 2, lines 41-50 and column 5, lines 30-36). Melling further teaches a plastic substrate (column 2, line 55 and column 7, line 20) where the layers are formed of fiber (column 9, lines 19-25) where the fiber can be cotton (column 11, lines 9-20). In instant claim 40, the paper being receptive to printing constitutes a

'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform. Henbo and Melling are analogous art because they are from the same field of security documents. It would have been obvious to one of ordinary skill in the art to include the security paper of Henbo comprising cotton and plastic fibers and having luminescent properties because Melling teaches the use of these fibers so only the highlight regions of the fibers are observed in transmitted light, improving the security features of the paper (column 10, lines 1-10).

***Claim Rejections – 35 USC § 103(a)***

6. Claim 29-34 and 36-45 rejected under 35 U.S.C. 103(a) as being unpatentable over Kaule (U.S. 5,817,205) in view of Henbo et al. (U.S. 5,871,833).

Kaule teaches making a security paper (column 3, lines 44-45 and column 6, lines 13-36) by applying a coat to the paper surface (column 5, lines 1-3) along with lacquers and printed protective layers (column 5, lines 59-65). Kaule teaches the paper comprising paper fibers (column 7, line 67) where the surface is suitable for producing isolated coated areas (column 8, lines 29-31). The reference discloses a paper machine cutting the paper to a desired size (column 9, lines 11-24). The coating of Kaule lacks both polyurethane and a filler substance. In claims 29, 30 and 38, the phrase, 'surface coating for improving durability of the paper layer' is directed to intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably

Art Unit: 1774

distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Additionally, in instant claim 38, the phrase, 'forming a surface dirt repellant film on the fibers of the paper' is directed to a product by process claim limitation, which is given little patentable weight in product claims. Although Kaule does not explicitly disclose a dirt repellant surface, it would have been obvious to one of ordinary skill in the art that the coating of Kaule repels dirt because the coating is provided with lacquers and printed protective layers (column 5, lines 59-65) which helps keep the security paper free from dirt. Kaule does not specifically disclose the coating layer comprising acrylates.

Henbo discloses a security paper comprising a support layer and coating layer (column 2, lines 26-28) where the coating layer includes acrylates and a mixture of acrylate and non-acrylate copolymers (column 5, lines 4-24).

Kaule and Henbo are analogous art because they are from the same field of security documents. It would have been obvious to one of ordinary skill in the art to include acrylates in the security document of Kaule because the acrylate material improves the binding properties of the coating layer.

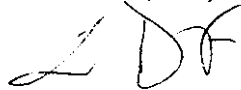
***Response to Arguments***

7. Arguments made in regards to rejection made under 35 USC 103(a) as being unpatentable over Detrick et al (U.S. 5,161,829) in view of Martin (U.S. 5,601,683) are rendered moot based on grounds of new rejection. Arguments made in regards to rejection made under 35 USC 103(a) as being unpatentable over Kaule (U.S. 5,817,205) are rendered moot based on grounds of new rejection.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson

